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10/696,894	10/30/2003	Gary W. Ramsden	331235-00019	9250

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EXAMINER

CASLER, TRACI

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3629

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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/696,894
Filing Date: October 30, 2003
Appellant(s): RAMSDEN ET AL.

John S. Paniagus
Katten Muchin Rosenman LLP

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 14, 2006 appealing from the
Office action mailed February 03, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on May 30, 2006 has not been entered as stated by appellant. The claims contained several improper changes made and several informalities that required correction before being entered. However, appellant has submitted a new set of claims as of November 14, 2006 which have been entered with corrections made and appear to reflect the claims submitted with the brief as Appendix A.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

49230221	Hsieh	5-1990
5065000	Pusic	11-1991
4863352	Tateno	6-1989

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 77 and 80 are found to be unpatentable according to 35 U.S.C. 103(a) over US Patent 4,923,022; Hsieh; Automatic mailing apparatus and further in view of US Patent 5,065,000 Pusic Automated Electronic Postage Meter Having a Direct Access Bar Code Printer.

As to claim 77 teaches a machine for mailing envelopes

- a. Receiving payment(C. 4 I. 14-17)
- b. Scale for weighing envelope and identifying weight(C. 3 I. 35)
- c. Type of mail service available displayed(C. 4 I. 1-3).
 - i. **displays postage of the delivery option selected by the user(C. 4 I. 9-12)**
- d. User selects delivery option and enters delivery information(C. 4 I. 4-5).
- e. Computes a cost for delivery(C. 4 I. 9-11).

Hsieh teaches stamping the envelope with postage but fails to teach printing a bar code label and receipt of purchase. Pusic teaches an automated electronic postage meter with a printer that prints both bar codes and receipts. (C. 3 I. 67-68; C. 4 I. 1-4). It would have been obvious to one skilled in the art at the time of invention to combine the teachings of Pusic with Hsieh so as to allow for quicker delivery with the use of the franking method of bar codes for reading a bar code and allowing the user proof of mailing the envelope.

As to claim 80 Hsieh teaches the payment means as a magnetic strip credit card reader(C. 4 I. 14-17).

Claims 79 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,923,022; Hsieh; Automatic mailing apparatus and further in view of US Patent 5,065,000 Pusic Automated Electronic Postage Meter Having a Direct Access Bar Code Printer.as applied to claims 78 and 80 above, and further in view of US Patent 4,836,352 Tateno; Express Package Collection Locker

As to claim 79 Hsieh and Pusic teach an automated postage machine, however they fail to teach the input means as a touch screen. Tateno teaches a touch screen in order to enter destination information(C. 5 I. 15-20). It would have been obvious to one skilled in the art at the time of invention to combine the teachings of Tateno with Hsieh and Pusic so as to have an alternative means of inputting information that can withstand the element of the environment in which the kiosk is located.

(10) Response to Argument

The appellant argues that the references fail to teach the limitation of the cost of postage as claimed. The appellant argues the prior art of record fails to teach the cost being a function of THREE variables, weight, destination and delivery option. However, the actual claim language only identifies two variables being used to determine the cost. The claim language reads...."a cost for mailing said parcel or envelope to said destination as a FUNCTION of said weight of said parcel or envelope and the selected delivery option. The function (calculation of cost) does not use the variable destination for determining. It is further noted that the although examiner has not made a inherency

reason for unpatentability for the three variables being used for postage cost the appellant has identified variables that are "inherent"(Pg. 6 Bullet points). Therefore, through appellants own admission it is inherent that the system will calculate cost based on the destination, delivery and weight of an item to be mailed. If the limitations the appellant is arguing as not being taught by the prior art but are also identified to be inherent by the appellant that would make the limitations obvious and unpatentable against the prior art of record. In response to appellants argument that the references fail to show certain features of appellants invention, it is noted that the features upon which appellant relies (i.e., calculating costs of different destinations for each selected delivery option on page 7 of brief) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The appellant further argues that the prior art merely hints at the limitation of selecting a delivery option. As noted above in the rejections Hsieh states "The customer may then choose the type of mailing service which sort of mailing type he/she desires by depressing one of the letter sorting keys"(C. 4 I. 1-4). Furthermore, appellants arguments are directed to the Pusic reference. Pusic was not relied on for the teaching of this limitation. Hsieh as previously stated was the reference that shows appellants limitations argued as unpatentable. Additionally, the examiner notes appellants limitation for selecting delivery option states "a display for displaying at least two selectable delivery options" broad in it's interpretation and not positively reciting the

selection of the delivery option. Therefore, the Hsieh's teaching of letter sorting keys meet the limitation as claimed. If the keys are able to be selected by the user they are obviously displayed somewhere on the apparatus.

As to appellants arguments that the examiner has failed a "reasonable expectation of success", the appellant has failed to provide evidence showing there is not a reasonable expectation of success to support their argument of nonobviousness. The examiner notes the reasoning of allowing for the placing of postage(bar code) on items larger than an envelope as well as use the barcodes to efficiently meet the needs of postal service users is in an of it self reasonable expectation for success of the combined references.

As to appellants arguments that the examiner fails to show a suggestion to combine. Appellant points to examiners response in paragraph 15 to action dated February 3, 2006, in which examiner is noting the dates of the references used in combination. This was in response to appellants arguments that the examiner was using hindsight as reasons for combination of reference that these limitation were not known at the time of invention. The examiner was noting the dates of the reference that taught the limitations combined were well known two years before appellants priority date for the instant application, therefore the limitations, suggestions, motivation and knowledge were generally available to one of ordinary skill in the art. Appellant notes that according to *Teleflex v. KSR* examiner must show that those skilled in the art at the time of invention were confronted with the same problem and would select elements of the cited prior art reference for combination. As noted in background of the invention for

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both Hsieh and Pusic that identify the problem of automating the process in order to meet the demands for mailing, sorting and tracking of items. Hsieh identifies the weighed, stamped and sorted letter as a time saving process for the postal workers(C. 1 I. 66-68) and Pusic identifies devices weight, calculate and print charges on the mailing(C. 1 I. 11-14) and that the barcode printed on a package or a label can be used for the automatic sorting and tracking process. Both Pusic and Hsieh identify the devices to be an improvement in the mailing of international mailings.

Therefore, the examiner has shown both knowledge and reasons/suggestions to combine the references of Pusic and Hsieh to show the unpatentability of appellants claims.

As to appellants arguments regarding the unpatentability of the claims as taught by the combination of Hsieh, Pusic and Tateno. The appellant argues that Tateno does not teach computing a cost of three variables. The examiner again notes it is not Tateno which is being relied on for these limitations being argued as well as the limitations as argued are not the limitations as they are claimed. The appellant alleges that the examiner fails to set forth a prima facie case of obviousness. As appellant fails to elaborate and set forth reasons and evidence why the combination is nonobvious the examiner is unable to reasonably understand appellant's support for the arguments. Therefore, in light of the appellant's lack of evidence the examiner deems a case of obviousness has been established and therefore has set forth proper reasons for unpatentability of the claimed limitations.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

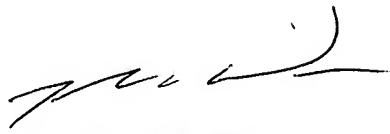
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